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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ICIWorld.net, Inc.

Serial No. 85789334

Mark A. Koch of Mark A. Koch, PC for ICIWorld.net, Inc.

Leslie L. Richards, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Quinn, Cataldo and Bergsman,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

ICIWorld.net, Inc. ("Applicant") seeks registration in standard characters on the Principal Register of the mark ICIWORLD for the following services, as amended:

providing information in the field of national and international real estate by means of linking the web site to other web sites featuring real estate information for a members-based community of real estate brokers and real estate professionals; providing national and international real estate listings and real estate information via the Internet to a members-based community of real estate brokers and real estate professionals

in International Class 36.¹

The Trademark Examining Attorney has refused registration of Applicant's mark on the ground of a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the registered mark ICI HOMES, in standard characters with HOMES disclaimed, for

residential real estate development and construction
in International Class 37.²

Applicant filed a request for reconsideration and appealed the final refusal. The Examining Attorney denied the request for reconsideration. The refusal has been fully briefed by Applicant and the Examining Attorney.

Based upon the record and the arguments made, we affirm the likelihood of confusion refusal.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also*, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated*

¹ Application Serial No. 85789334 was filed on November 18, 2012, based upon Applicant's allegation of first use of the mark anywhere and in commerce on December 31, 1994 under Section 1(a) of the Trademark Act.

² Registration No. 2685749 issued on the Principal Register on February 11, 2003. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First Renewal.

Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Strength of Registrant's Mark

Prior to our consideration of the involved marks, we will consider Applicant's argument that the term ICI in Registrant's ICI HOMES mark is weak as a result of third-party registration of similar marks for related goods. In support of its argument, Applicant has made of record copies of approximately twenty third-party registrations for ICI-formative marks for a variety of goods and services, of which the following may be considered the most relevant:

Registration No. 3394656 for the mark ICI for video tapes, audio tapes, and CDs containing information regarding the mutual fund and investment company industry and financial investing;

Registration No. 3204807 for the mark ICI for a wide variety of goods and services in 19 International Classes, including various building materials and insulation, building repair, renovation, refurbishing and maintenance services;

Registration No. 3882059 for the mark shown below for, *inter alia*, engineering services for building and property condition assessment; facility repair and restoration, evaluation and testing of real estate for the presence of hazardous material;



Registration No. 4033275 for the mark shown below for, *inter alia*, heating boilers, gas boilers, boilers for hot water production for domestic and industrial use, central heating installations consisting of boilers and gas, oil burners; and



Registration No. 4235826 for the mark ICI ET LA for, *inter alia*, real estate agencies, real estate brokerage services, construction management, demolition of buildings, cleanup, upkeep, maintenance, repairs to buildings.

With regard to these third-party registrations, we first note that such registrations are not evidence of use of the marks shown therein and, therefore, are not proof that consumers are familiar with said marks so as to be accustomed to the existence of similar marks in the marketplace. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). Second, with one exception these registrations identify goods and services which are not as closely related to those in the cited registration as Applicant's recited services. Registration No. 4235826 identifies services more closely related to those in the cited registration, however, the mark ICI

ET LA, translated in the registration into “here and there,” is farther removed from the mark in either the cited registration or involved application. As such, these third-party registrations have very limited probative value for purposes of demonstrating the asserted weakness of Registrant’s ICI HOMES mark for the services recited therein.

On the record in this case, we find insufficient support for Applicant’s argument that the ICI HOMES mark in the cited registration is weak in the field of “residential real estate development and construction” and entitled to only a narrow scope of protection. *See Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff’d unpublished.*, (No. 92-1086 Fed. Cir. (June 5, 1992). *Cf. In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996).

Similarity of the Marks

We turn then to our comparison of the two marks in their entireties and, in doing so, look to their appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). We keep in mind that, under this factor, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison; “[i]nstead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or

sponsorship is likely.” *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d at 1741; *see also*, *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). Thus, although we place the marks alongside each other in the following paragraph for purposes of this decision, consumers will rarely have the luxury of viewing the marks in such a manner.

In this case, Applicant’s ICIWORLD mark is similar to Registrant’s ICI HOMES mark to the extent that both share the identical term “ICI” as the first component term thereof. We observe that “HOMES” is disclaimed in Registrant’s mark, and appears to be, at best, highly suggestive of the real estate development and construction services recited in the registration. The term “WORLD” in Applicant’s mark appears to suggest the international scope of the real estate information services identified in the involved application. As a result, we find the terms “HOMES” and “WORLD” in the respective marks to serve as less of a source identifier than the term “ICI” common to both. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Furthermore, the significance of the term “ICI” is reinforced by its location as the first word in the marks. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered”). *See also Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word).

In its September 25, 2013 communication, Applicant asserts (p. 10) that its mark is “a term coined by applicant by combining INDUSTRIAL COMMERCIAL INVESTMENT (ICI) and **WORLD**.³ A printed copy of a page from Applicant’s Internet website, submitted with its communication (p. 21) states “Welcome to the world of industrial, commercial, investment (ICI) and residential real estate!” In its brief, Applicant “submits that the term ICI is an acronym which, in and of itself, has absolutely no meaning or significance in the ‘real estate’ industry.”⁴ The record is unclear regarding the meaning of “ICI” as it appears in Registrant’s ICI HOMES mark. Thus, the term “ICI” is identical in appearance and sound in both marks and, to the extent purchasers will ascribe a meaning thereto in Applicant’s mark, it appears to be, at worst, slightly suggestive of the recited services and appears arbitrary in Registrant’s mark.

³ Emphasis in original.

⁴ 7 TTABVue 11. Record citations are to TTABVue, the Trademark Trial and Appeal Board’s publically available docket history system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

While “HOMES” and “WORLD,” differ in appearance and sound, both suggest a characteristic of the services offered thereunder. As a result, when the marks ICI HOMES and ICIWORLD are viewed in their entirety, they are more similar than dissimilar in appearance and sound, and give the impression of being variations on each other that nonetheless point to a common source. In view of the foregoing, we find that the similarities in the marks outweigh the differences, and that this *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The Services

We turn now to the *du Pont* factor involving the relatedness of Applicant’s services and Registrant’s services. It is settled that in making our determination, we must look to the services as identified in the application vis-à-vis those recited in the cited registration. *See Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). It is also not necessary that the respective services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective services are related in some manner, or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the

similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

In this case, Applicant's services involve providing real estate listings and information to real estate brokers and real estate professionals and Registrant's services are "residential real estate development and construction." In support of the refusal to register, the Examining Attorney made of record with her November 8, 2103 Final Office Action the following definition of "real estate:" – "property consisting of buildings and land; the business of selling land and buildings."⁵ The Examining Attorney also made of record evidence from informational and commercial Internet websites of which the following are illustrative to suggest that firms providing real estate information and listing services also provide real estate development and construction services of the type recited in the involved application and registration.

Welcome to Markovich Inc. Construction, Real Estate and Development Firm.

Providing a superior level of informed professional real estate services to buyers and sellers in the greater Butte area including an excellence in your construction and development needs.

BUYERS!

Automatically receive personalized MLS listings by e-mail. Early each morning we search the local MLS and find the homes that match your criteria and notify you immediately with the latest listing information!!

CONSTRUCTION!

Markovich Construction Projects In Progress

Click on this link to go to current Markovich projects in progress.

(markovichinc.com);

⁵ Merriam-webster.com/dictionary

Coastline Realty & Construction, LLC

Real Estate Sales – Our service, experience and dedication provide motivated Sellers and Buyers with a clear marketing advantage.

New Construction Services – Coastline Realty and Construction, LLC builds quality homes in Eastern NC.
(coastlineobx.com);

SNOW Realty & Construction

If you are looking to reside in North Carolina or Virginia you will find all real estate listing[s] here in the Triad on our website. Snow Realty and Construction offering NC & VA Real Estate and Custom Home Construction for full time residence or vacation getaways for those looking to relocate, move up, downsize, or the first time homebuyer.

(snowrealtyandconstruction.com); and

Beach Realty & Construction

Property Search Real Estate Tips Communities Construction

Our Outer Banks home sales website offers detailed mapping, the ability to save your search criteria, automatic notification of new listings, and so much more. Please take advantage of the many features and services provided by our site and let us become your number one source for real estate information and NC coastal property searches.

With over thirty years of coastal construction experience, Beach Realty & Construction / Kitty Hawk Rentals is the first name in quality building on the Outer Banks. We build everything from custom homes to condominium projects and commercial ventures.

(beachrealtysales.com).

The foregoing evidence suggests that Registrant's services may emanate from the same sources as services of a type related to Applicant's services.

In addition, the Examining Attorney has made of record twenty use-based third-party registrations which show that various entities have adopted a single mark for services of a type similar to those identified in the involved application and cited registration. *See*, for example:

Registration No. 2577834 for real estate development, real estate listings and land acquisition, namely, real estate brokerage;

Registration No. 3456321 for, *inter alia*, providing information in the field of real estate by means of linking the web site to other web sites featuring real estate information, providing real estate listings and real estate information via the Internet, housing services, namely, development of real property, namely, repair, improvement and new construction;

Registration No. 3485558 for, *inter alia*, real estate listing, providing information in the field of real estate by means of websites featuring real estate information, real estate development; and

Registration No. 3707467 for, *inter alia*, providing real estate listings and real estate information via the Internet, real estate development.

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *See In re Association of the United States Army*, 85 USPQ2d 1264, 1270 (TTAB 2007); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

The evidence of record establishes that Applicant's services are related to the services identified in the cited registration, and further may be identified under the same mark. As such, this *du Pont* factor favors a finding of likelihood of confusion.

Channels of Trade

In making our determination regarding the relatedness of the channels of trade, we look as we must to the services as identified in the involved application and cited registration. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 16 USPQ2d at 1787. *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). It is presumed that the construction and real estate development services and real estate listing and information services at issue move in all channels of trade normal for such services, and that they are purchased by all of the usual consumers for such services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958). Applicant's services specify that they are provided to "real estate brokers and real estate professionals." Here, the Examining Attorney's third-party evidence clearly suggests that the services are not only related, but may in fact be offered by the same firms, to the same customers. Thus, even if Applicant's real estate information and listing services are marketed in the specified trade channels, they nonetheless will be made available to the same consumers as Registrant's related services that do not recite any limitations to the trade channels in which they are offered. As such, this *du Pont* factor is, at worst, neutral or slightly favors a finding of likelihood of confusion.

Sophistication of Purchasers

As discussed above, the involved application indicates that Applicant's services are provided to real estate brokers and professionals. The cited registration does not include any limitations on the customers to whom Registrant's services are rendered, so we must consider the relevant purchasers to include all of the usual customers for its recited services. *See In re Elbaum*, 211 USPQ at 640. Because the evidence of record supports a finding that the respective services may emanate from a common source, Registrant's consumers must thus be presumed to include real estate professionals and brokers. Even if we accept, in considering the fourth *du Pont* factor, Applicant's assertion that the involved services may be the subject of sophisticated purchases, even careful purchasers are likely to be confused by similar marks used in connection with related services. As stated by our primary reviewing court, "[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. 'Human memories even of discriminating purchasers ... are not infallible.'" *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970).

Therefore, even if it is true in this case, the fact that the purchasers may exercise care before purchasing these services does not mean there can

be no likelihood of confusion. In the present case, the similarity between the marks and the similarity between the services as identified outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). As such, this *du Pont* factor is, at best, neutral or slightly favors a finding of no likelihood of confusion.

Lack of Actual Confusion

The final *du Pont* factor discussed by Applicant and the Examining Attorney is that of the lack of instances of actual confusion. Applicant asserts that the absence of actual confusion for over 14 years suggests no likelihood of confusion. However, and as pointed out by the Examining Attorney, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Particularly in an *ex parte* proceeding, Applicant's assertion of the absence of actual confusion is of little probative value in our determination on the issue of likelihood of confusion because the Board cannot readily determine whether there has been a significant opportunity for actual confusion to have occurred, such that the absence of confusion is meaningful. See *In re Opus One Inc.*, 60 USPQ2d 1812, 1817

(TTAB 2001); *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); and *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984).

Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. *See In re Majestic Distilling Co.*, 65 USPQ2d at 1205 (“uncorroborated statements of no known instances of actual confusion are of little evidentiary value.”). *See also, In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992).

Conclusion

Because the marks are similar, the services are related, with services offered in some of the same trade channels, we find that Applicant’s mark, if used in association with the services identified in the application, is likely to cause confusion with the registered mark in connection with the services recited in the registration.

Decision: The likelihood of confusion refusal to register Applicant’s mark is affirmed.